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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,200	01/02/2002	John C Rogers	P 283207	9600

909 7590 05/30/2003  
PILLSBURY WINTHROP, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

ZEMAN, MARY K

ART UNIT PAPER NUMBER

1631

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/914,200

Applicant(s)

ROGERS, JOHN C

Examiner

Mary K Zeman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Notice to Comply*.

### **DETAILED ACTION**

Claims 1-9 are pending in this application. This application is a national stage application of international application US00/04338. This application also claims priority to provisional application 60/121,432, filed 2/23/1999. The examiner has considered and reviewed the information provided by the IB for the international application.

The processing of the computer readable format of the sequence listing was corrected by STIC personnel to remove a minor formatting error in SEQ ID NO: 8. Hard returns were entered to delineate data appropriately.

The Information Disclosure Statement filed with the application has been considered. Initialed copies of the form 1449 are included with this action.

The Drawings submitted with the application are satisfactory to the examiner.

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. see at least page 1, page 17, page 18.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. ' 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. " 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. See

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page 18 for the peptide sequence. Applicant must respond to this objection or the reply will be held non-responsive.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomonaga et al. (US 6,199,017).

The claims are drawn to a system and a computer program for managing and presenting information. The system must comprise a data represented map of metabolic pathways, which comprise graphical representations of a reaction, substrate, product and catalyst, and an association mechanism. The program must provide instructions to associate the reactions.

Tomonaga et al. (US 6,199,017) provides systems and computer programs for the management and display of metabolic pathways. The pathways can be chemical reactions, or enzyme mediated reactions. Information from literature databases are linked, which includes information of gene sequences. The systems of Tomonaga et al. associate data to the reactions. The programs provide code for such associations. As such, they meet the limitations of the pending claims.

Claims 1-9 rejected under 35 U.S.C. 102(b) as being anticipated by Tomonaga et al. WO 96/29659.

This reference is the WO publication from which the above US Patent (6,199,017) matured, and contains the same disclosure.

Tomonaga et al. (US 6,199,017) provides systems and computer programs for the management and display of metabolic pathways. The pathways can be chemical reactions, or enzyme mediated reactions. Information from literature databases are linked, which includes information of gene sequences. The systems of Tomonaga et al. associate data to the reactions. The programs provide code for such associations. As such, they meet the limitations of the pending claims.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Schilling et al. (1998).

Schilling et al. (PNAS USA, April 1998, Vol. 95, pages 4193-4198) disclose systems and programs for organizing, managing and displaying data involved in metabolic pathways. These

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systems allow for various types of map displays illustrating the linkages between sequences, genes, enzymes, activities, etc. Information from gene expression profiles, once validated and assigned a function can also be included. Substrate, catalyst and product can all be included. As such this disclosure meets the limitations of the claims.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Thalhammer-Reyero (US 5,980,096).

This patent discloses computer based systems and programs for the management and display of data regarding complex biological systems. These systems can be used for organizing, managing and displaying data involved in metabolic pathways. These systems allow for various types of map displays illustrating the linkages between sequences, genes, enzymes, activities, etc. Information from gene expression profiles, once validated and assigned a function can also be included. Substrate, catalyst and product can all be included. As such this disclosure meets the limitations of the claims.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hogue et al. (US 2002/0072865).

This patent discloses computer based systems and programs for the management and display of data regarding complex biological systems. These systems can be used for organizing, managing and displaying data involved in metabolic pathways. These systems allow for various types of map displays illustrating the linkages between sequences, genes, enzymes, activities, etc. Information from gene expression profiles, once validated and assigned a function can also

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be included. Substrate, catalyst and product can all be included. As such this disclosure meets the limitations of the claims.

This disclosure has priority to 2/11/1999, which precedes the effective filing date of this application.

### *Conclusion*

No claim is allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

Official fax numbers for this Art Unit are: (703) 308-4242, (703) 872-9306. An *unofficial* fax number, direct to the Examiner is (703) 746 5279. Please call prior to use of this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz  
5/28/03

  
MARY K. ZEMAN  
PRIMARY EXAMINER  
